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Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

# TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER A PRIOR PATENT

Docket Number (Optional)

In re Application of: LOUIS T. GNECCO and Paula S. Gnecco  
 Application No. 081835,350  
 Filed: 04/07/97  
 For: ELECTROMAGNETICALLY SHIELDED HEARING AID

The owner, GNECCO ET AL. of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 5,640,457. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☐ The undersigned is an attorney of record.

1/13/99  
Date

Louis Gnecco  
Signature  
Paula S. Gnecco  
Typed or printed name

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) included.  
☐ PTO suggested wording for terminal disclaimer was

LOUIS GNECCO  
PAULA S. GNECCO

☐ unchanged. ☐ changed (if changed, an explanation should be supplied).

01/14/1999 KWARD 08639330

01 FC:248

This form is estimated to take .2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time required to complete this form should be sent to the Office of Assistance Quality and Enhancement Division, Patent and Trademark Office, Washington, DC 20231, and to the Office of Information and Regulatory Affairs, Office of Management and Budget (Project 0651-0031), Washington, DC 20503. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner of Patents and Trademarks, Washington, DC 20231.

# Office Action Summary

Application No.  
08/835,350

Applicant(s)  
LOUIS AND PAULA GNECCO

Examiner  
REXFORD BARNIE

Group Art Unit  
2743



☒ Responsive to communication(s) filed on Apr 7, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 21 and 22 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 21 and 22 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Specification***

1. If applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed. In summary, the disclosure of the present application should be the same as that of the first application with the claimed changes namely; 800-2500Hz and the new drawings incorporated into the original specification.

### ***Claim Objections***

2. Claims 21 and 22 are objected to because of the following informalities: The claims are in a dependent form and therefore, cannot be examined. Thus, the applicant is advised to incorporate the newly written claims in the original claimed subject matter in order to put the claim(s) in an independent form thus making it possible to examine the claimed subject matter. Appropriate correction is required.

3. The applicant is advised to incorporate the newly claimed changes into the original specification and claims and file the application as such in order to put the application in condition for examination.

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***Double Patenting***

4. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and © may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

In layman's terms, the applicant seems to disclose the same subject in both applications namely, shielding a hearing aid against electromagnetic field and therefore, the applicant would have to file a terminal disclaimer in order to put the application in condition for allowance which means that the new application (08/835,350) would be allowed on the basis that the original and the new application would expired at the same time and if the applicant decides to sell the claimed subject matter, both would have to be given to the buyer.


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***Conclusion***

5. Any inquiry concerning this communication or earlier communication from the examiner should be directed to REXFORD BARNIE whose telephone number is **(703) 306-2744**. The examiner can normally be reached on Monday through Friday from 8:30 to 6:00p:m

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz, can be reached on (703) 305-4708. The **informal fax number** (Draft or Proposed Amendment) for this Group is (703) 305-9508 wherein the **formal fax number** for the group is (703) 305-9051 or 305-9052. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 305-3900.

R.B. 06/11/98.



PAUL LOOMIS  
PRIMARY EXAMINER

Form PTO 948 (Rev. 8-98)

U.S. DEPARTMENT OF COMMERCE - Patent and Trademark Office

Application No. 835350NOTICE OF DRAFTSPERSON'S  
PATENT DRAWING REVIEW

The drawing(s) filed (insert date) \_\_\_\_\_ are:

A. ☐ approved by the Draftsperson under 37 CFR 1.84 or 1.152.B. ☐ objected to by the Draftsperson under 37 CFR 1.84 or 1.152 for the reasons indicated below. The Examiner will require submission of new, corrected drawings when necessary. Corrected drawing must be submitted according to the instructions on the back of this notice.

<p>1. DRAWINGS. 37 CFR 1.84(a): Acceptable categories of drawings:</p> <p>Black ink. Color drawings are not acceptable until petition is granted. Fig(s) _____</p> <p>2. PHOTOGRAPHS. 37 CFR 1.84(b)</p> <p>1 full-tone set is required. Fig(s) _____</p> <p>Photographs not properly mounted (must use bristol board or photographic double-weight paper). Fig(s) _____</p> <p>Fair quality (half-tone). Fig(s) _____</p> <p>3. TYPE OF PAPER. 37 CFR 1.84(c)</p> <p>Paper not flexible, strong, white, and durable. Fig(s) _____</p> <p>Erasures, alterations, overwritings, interlineations, and markings not acceptable. Fig(s) _____</p> <p>4. SIZE OF PAPER. 37 CFR 1.84(f): Acceptable sizes:</p> <p>21.0 cm by 29.7 cm (DIN size A4)</p> <p>21.6 cm by 27.9 cm (8 1/2 x 11 inches)</p> <p>All drawing sheets not the same size. Fig(s) _____</p> <p>Sheet(s) _____</p> <p>Drawings sheets not an acceptable size. Fig(s) _____</p> <p>5. MARGINS. 37 CFR 1.84(g): Acceptable margins:</p> <p>Top 2.5 cm Left 2.5 cm Right 1.5 cm Bottom 1.0 cm</p> <p>SIZE: A4 Size</p> <p>Margins not acceptable. Fig(s) _____</p> <p>Top (T) _____ Left (L) _____</p> <p>Right (R) _____ Bottom (B) _____</p> <p>6. VIEWS. 37 CFR 1.84(h)</p> <p>REMINDER: Specification may require revision to correspond to drawing changes.</p> <p>Partial views. 37 CFR 1.84(h)(2)</p> <p>Brackets needed to show figure as one entity. Fig(s) _____</p> <p>Views not labeled separately or properly. Fig(s) _____</p> <p>Enlarged view not labeled separately or properly. Fig(s) _____</p> <p>7. SECTIONAL VIEWS. 37 CFR 1.84(h)(3)</p> <p>Hatching not indicated for sectional portions of an object. Fig(s) _____</p> <p>Sectional designation should be noted with Arabic or Roman numbers. Fig(s) _____</p>	<p>8. ARRANGEMENT OF VIEWS. 37 CFR 1.84(i)</p> <p>Views do not appear on a horizontal, left-to-right fashion when page is either upright or turned so that the top becomes the right side, except for graphs. Fig(s) _____</p> <p>9. SCALE. 37 CFR 1.84(k)</p> <p>Scale not large enough to show mechanism without crowding when drawing is reduced in size to two-thirds in reproduction. Fig(s) _____</p> <p>10. CHARACTER OF LINES, NUMBERS, &amp; LETTERS. 37 CFR 1.84(i)</p> <p>Lines, numbers &amp; letters not uniformly thick and well defined, clean, durable, and black (poor line quality). Fig(s) _____</p> <p>11. SHADING. 37 CFR 1.84(m)</p> <p>Solid black areas pale. Fig(s) _____</p> <p>Solid black shading not permitted. Fig(s) _____</p> <p>Shade lines, pale, rough and blurred. Fig(s) _____</p> <p>12. NUMBERS, LETTERS, &amp; REFERENCE CHARACTERS. 37 CFR 1.84(p)</p> <p>Numbers and reference characters not plain and legible. Fig(s) _____</p> <p>Figure legends are poor. Fig(s) _____</p> <p>Numbers and reference characters not oriented in the same direction as the views. Fig(s) _____</p> <p>English alphabet not used. 37 CFR 1.84(p)(2)</p> <p>Numbers, letters and reference characters must be at least .32 cm (1/8 inch) in height. 37 CFR 1.84(p)(3)</p> <p>Fig(s) _____</p> <p>13. LEAD LINES. 37 CFR 1.84(q)</p> <p>Lead lines cross each other. Fig(s) _____</p> <p>Lead lines missing. Fig(s) _____</p> <p>14. NUMBERING OF SHEETS OF DRAWINGS. 37 CFR 1.84(i)</p> <p>Sheets not numbered consecutively, and in Arabic numerals beginning with number 1. Sheet(s) _____</p> <p>15. NUMBERING OF VIEWS. 37 CFR 1.84(u)</p> <p>Views not numbered consecutively, and in Arabic numerals, beginning with number 1. Fig(s) _____</p> <p>16. CORRECTIONS. 37 CFR 1.84(w)</p> <p>Corrections not made from prior PTO-948 dated _____</p> <p>17. DESIGN DRAWINGS. 37 CFR 1.152</p> <p>Surface shading shown not appropriate. Fig(s) _____</p> <p>Solid black shading not used for color contrast. Fig(s) _____</p>
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## COMMENTS

REVIEWER John F. HumpfDATE 1/13/99TELEPHONE NO. 203 345 0895ATTACHMENT TO PAPER NO. 4